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In re Application of :
BATHURST et al. :
Application No.: 10/535,609 : DECISION
PCT No.: PCT/GB2003/005049 :
Int. Filing Date: 20 November 2003 :
Priority Date: 20 November 2002 :
Attorney Docket No.: GJE-7631 :
For: COMPOSITION AND METHOD FOR :
TREATING INFLAMMATORY DISEASES :
USING PROTEASE INHIBITORS :
:

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 12 June 2006 in the United States Patent and Trademark Office (USPTO). The petition is DISMISSED without prejudice.

BACKGROUND

On 20 November 2003, applicants filed international application PCT/GB2003/005049, which designated the United States and claimed a priority date of 20 November 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 03 June 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 20 May 2005.

On 19 May 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 09 December 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage were required.

On 12 June 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a four month extension of time, the surcharge under 37 CFR 1.492(h), and a declaration of inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee is \$200. The balance of \$70 has been charged to Deposit Account 19-0065. Thus, item (1) has been met.

Item (4) has been met as well.

Item (3) has not been met. A statement of the last known address of each of the four non-signing joint inventors has not been provided.

Item (2) has not been met. MPEP § 409.03(d), item I states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

...
The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included >in the< statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, no statement of facts has been provided. A statement of facts by a person having firsthand knowledge of the facts recited therein must be provided. For example, a statement of facts by the person or persons who sent the letters accompanying the petition and a statement of facts by the person or persons who sent and/or received the e-mails accompanying the petition must be provided.

Additionally, it is not clear whether it is being alleged that the four non-signing inventors refuse to execute the application or that they cannot be reached after diligent effort. The two are distinct. *See, e.g.*, MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join."

-If it is being alleged that one or more of the non-signing inventors refuses to sign, the inventor or inventors must be presented with a complete copy of the application papers (specification, including claims, drawing, and oath or declaration) for a refusal to be established.

-If it is being alleged that one or more of the non-signing inventors cannot be reached or found, copies of documentary evidence such as *internet searches*, certified mail return receipts, cover

letters of instructions, and telegrams, that support a finding that the non-signing inventor or inventors could not be found or reached should be made part of the affidavit or declaration. See MPEP § 409.03, item I.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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